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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,356	05/25/2001	Robert Bennett	1087.1013	4093

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EXAMINER

GIBSON, RANDY W

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,356

Applicant(s)

BENNETT ET AL.

Examiner

Randy W. Gibson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-20, 23-34, 39, 40, 45, 46, 51 and 52 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 21, 22, 35-38, 41-44, 47-50, 53 and 54 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 5. 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

2. Claims 1, 4, 6-18, 24-34, 39, 40, 45, 46, 51, and 52 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mosher. The "metal detection system" which supports a "metal test piece" is the hopper (or conveyor belt (204) in one embodiment) which is used to hold the metal test object until it is discharged along with the contents of other hoppers in a test run (Col. 6, lines 12-60) during normal operation of the apparatus, and the plastic chute (Col. 3, lines 54-57) which allows proper operation of the metal detector. Note that since the metal ball is used again, it is considered to have moved from a first position to a second position and back again.

3. Claims 12-14, 17, 18, 25-29, 33, 34, 39, and 40 are rejected under 35 U.S.C. 102(f) as being clearly anticipated by the applicant's own admission of prior art in the written description (page 1). See *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, 610 (CCPA 1975); and *MPEP* § 2129. Note that since the metal test ball is intended to be

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used again, then it is considered to have moved from a first position to a second position and back again.

4. Claims 1, 6-10, 12, 16-20, 23, 25-27, 29, 31, and 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thompson.

5. Claims 1, 4, 8, 9, 11-13, 14, 16, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nisshin (JP 09 072885). See the European Search Report.

6. Claims 1, 2, 6-10, 12-20, and 23-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hannam et al (EP 0 418 069 A2).

7. Claims 1, 2, 6-10, 12-20, and 23-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hannam et al (GB 2 235 981 A).

Conclusion

8. Claims 3, 5, 21, 22, 35-38, 41-44, 47-50, 53, and 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy W. Gibson whose telephone number is (703) 308-1765. The examiner can normally be reached on Mon-Fri., 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David S Martin can be reached on (703) 308-3121. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-5115.

February 6, 2003


Randy W. Gibson
Primary Examiner
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